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| 09/407,126 | 09/27/1999 | ROBERT W. BOSSEMEYER JR. | 8285/314 | 2323 |
| 757 | 7590 | 01/17/2006 | | |
| BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610 | | | EXAMINER BORISSOV, IGOR N | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3639 | |
| DATE MAILED: 01/17/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/407,126

Applicant(s)

BOSSEMEYER ET AL.

Examiner

Igor Borissov

Art Unit

3639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,6-12,14-19 and 21-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6-12,14-19 and 21-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Amendment received on 10/24/2005 is acknowledged and entered. Claims 4, 13 and 20 have previously been canceled. Claims 1, 9, 10 and 17 have been amended. Claims 1-3, 6-12, 14-19 and 21-26 are currently pending in the application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, 5-12, 14-19 and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alcott (US 6,324,273) in view of Panizzon (US 4,219,700) (Panizzon) and further in view of Majmudar et al. (US 4,897,866) (Majmudar).

Alcott teaches a computer-implemented method and system for ordering a telecommunication service, comprising:

As per claims 1, 10 and 17,

determining, in accordance with an inquiry of a party, an availability of a telecommunication feature for the party of a telecommunication network (C. 3, L. 62 - C. 4, L. 4);

identifying the party of the telecommunication network and the telecommunication feature unavailable to the first party in accordance with said inquiry (C. 3, L. 48 - 53; C. 3, L. 62 - C. 4, L. 4);

providing availability data which indicates an availability of the telecommunication feature to a portion of the telecommunication network which serves the party (C. 3, L. 62 - C. 4, L. 4);

determining that the telecommunication feature has become available to the party based on the first data structure and the availability data (C. 4, L. 15-25). As per "storing" feature, Alcott teaches the computer-implemented method, wherein the steps of: "identifying the party of the telecommunication network and the telecommunication feature unavailable to the first party" are performed by the order processor (44), thereby indicating storing step (C. 3, L. 48-53).

Alcott does not specifically teach that inputting said availability data, which indicates availability of the telecommunication feature to a portion of the telecommunication network serving the party, is occurring after completion of the first transaction; and after upgrading the portion of the telecommunication network which serves the party. Also, Alcott does not specifically teach placing a call to the first party to inform the first party that the first telecommunication feature has become available, wherein the placing of the call occurs in response to the inquiring in the first transaction, the upgrading the portion of the communication network and the processing of the first data structure and the availability data.

Panizzon teaches a method and system for party line subscriber interface circuit, wherein a telephone service subscriber, after inquiring for a telecommunication feature, said feature was unavailable for the subscriber, and after completing the inquiry, and after the processing the availability of said feature (processing of the first data structure), was informed that said feature had become available to the subscriber (C. 2, L. 48-54; C. 9, L. 57 - C. 10, L. 7). Panizzon specifically teaches that said "informing" is conducted by causing the subscriber's handset to ring (C. 2, L. 53-54), thereby indicating ability to inform said subscriber by placing a call.

Majmudar teaches a method and system for telecommunication arrangement, wherein, after a subscriber selects (inquires) a desired specific telecommunication feature, the inquiry is processed, and appropriate software modules are assembled (the system is upgraded) to enable the requested feature. After this event, if user lifts a handset to originate a call, the requested feature is available (C. 6, L. 1-17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Alcott to include that inputting said availability data, which indicates an availability of the telecommunication feature, is occurring after completion of the first transaction, and placing a call to the first party to inform the first party that the first telecommunication feature has become available, as taught by Panizzon, because it would advantageously improve customer service of the service providers by allowing subscribers to inquire for the desired feature only once. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Alcott and Panizzon to include that inputting said availability data is occurring after upgrading the portion of the telecommunication network which serves the party, as taught by Majmudar, because it would advantageously allow to accommodate various needs subscribers may have, thereby make the system more attractive to customers.

As per *first* party and *first* telecommunication feature, the method steps, disclosed in Alcott, Panizzon and Majmudar would be performed the same regardless how many parties make inquiries for a service, and how many telecommunication features are available for the service. Furthermore, Alcott teaches:

As per claims 2, 11 and 18,

identifying another party of the telecommunication network and another a telecommunication feature unavailable to another party; determining an availability of the telecommunication feature for another party of a telecommunication network; and determining that the telecommunication feature unavailable to another party (C. 3, L. 48 -53; C. 3, L. 62 - C. 4, L. 4). As per "storing" feature, Alcott teaches the computer--implemented method, wherein the steps of "identifying the party of the telecommunication network and the telecommunication feature unavailable to the first party" are performed by the order processor (44), thereby indicating storing step (C. 3, L. 48-53).

As per *second* party and *first* telecommunication feature, the method steps, disclosed in Alcott, Panizzon and Majmudar would be performed the same regardless how many

parties make inquiries for a service, and how many telecommunication features are available for the service.

As per claims 3, 12 and 19, identifying another party of the telecommunication network and another telecommunication feature unavailable to another party; and determining that another telecommunication feature unavailable to another party (C. 3, L. 48 -53; C. 3, L. 62 - C. 4, L. 4). As per "storing" feature, Alcott teaches the computer-implemented method, wherein the steps of "identifying the party of the telecommunication network and the telecommunication feature unavailable to the first party" are performed by the order processor (44), thereby indicating storing step (C. 3, L. 48-53). As to *second* party and *first* telecommunication feature, the method steps, disclosed in Alcott, Panizzon and Majmudar would be performed the same regardless how many parties make inquiries for a service, and how many telecommunication features are available for the service.

As per claim 5, said method and system, comprising: prior to inputting the availability data, receiving a call from the party, and informing in the call that the first telecommunication feature is unavailable to the party (C. 1, L. 11-33; C. 3, L. 41 - C. 4, L. 4).

As per claims 6, 14 and 21, said method and system, wherein the first telecommunication feature comprises a telecommunication service (C. 1, L. 6-7).

As per claims 7, 15 and 22, said method and system, wherein the first telecommunication feature comprises a telecommunication product (C. 1, L. 6-7).

As per claims 8, 16 and 23, said method and system, wherein the telecommunication network comprises a telephone network (C. 1, L. 62 - C. 2, L. 12).

As per claim 9,
determining an availability of a telecommunication feature for the party of a telecommunication network in accordance with an inquiry of a party (C. 3, L. 62 - C. 4, L. 4);

storing a first data structure which identifies the party of the telecommunication network and the telecommunication feature unavailable to the first party in accordance with said inquiry (C. 3, L. 48-53; C. 3, L. 62 - C. 4, L. 4);

providing availability data which indicates an availability of the telecommunication feature to a portion of the telecommunication network which serves the party (C. 3, L. 62 - C. 4, L. 4);

determining that the telecommunication feature has become available to the party based on the first data structure and the availability data (C. 4, L. 15-25). As per "storing" feature, Alcott teaches the computer-implemented method, wherein the steps of "identifying the party of the telecommunication network and the telecommunication feature unavailable to the first party" are performed by the order processor (44), thereby obviously indicating storing step (C. 3, L. 48-53).

Alcott does not specifically teach that inputting said availability data, which indicates availability of the telecommunication feature to a portion of the telecommunication network serving the party, is occurring after completion of the first transaction; and after upgrading the portion of the telecommunication network which serves the party. Also, Alcott does not specifically teach placing a call to the first party to inform the first party that the first telecommunication feature has become available, wherein the placing of the call occurs in response to the inquiring in the first transaction, the upgrading the portion of the communication network and the processing of the first data structure and the availability data.

Panizzon teaches a method and system for party line subscriber interface circuit, wherein a telephone service subscriber, after inquiring for a telecommunication feature, said feature was unavailable for the subscriber, and after completing the inquiry, and after the processing the availability of said feature, was informed that said feature had become available to the subscriber (C. 2, L. 48-54; C. 9, L. 57 - C. 10, L. 7). Panizzon specifically teaches that said "informing" is conducted by causing the subscriber's handset to ring (C. 2, L. 53-54), thereby indicating ability to inform said subscriber by placing a call.

Majmudar teaches a method and system for telecommunication arrangement, wherein, after a subscriber selects (inquires) a desired specific telecommunication feature, the inquiry is processed, and appropriate software modules are assembled (the system is upgraded) to enable the requested feature.

After this event, if user lifts a handset to originate a call, the requested feature is available (C. 6, L. 1-17).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Alcott to include that inputting said availability data, which indicates an availability of the telecommunication feature, is occurring after completion of the first transaction, and placing a call to the first party to inform the first party that the first telecommunication feature has become available, as taught by Panizzon, because it would advantageously improve customer service of the service providers by allowing subscribers to inquire for the desired feature only once. And it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Alcott and Panizzon to include that inputting said availability data is occurring after upgrading the portion of the telecommunication network which serves the party, as taught by Majmudar, because it would advantageously allow to accommodate various needs subscribers may have, thereby make the system more attractive to customers.

Also, Alcott, Panizzon and Majmudar do-not specifically teach a first party, a second party and a third party, which inquire for a first, second and third features. However, the method steps disclosed in Alcott, Panizzon and Majmudar indicate continuity of the disclosed method. As to *first, second and third* party and *first, second and third* telecommunication features, the method steps, disclosed in Alcott, Panizzon and Majmudar would be performed the same regardless how many parties make inquiries for a service, and how many telecommunication features are available for the service.

As per claims 24-26, Panizzon teaches that a telephone service subscriber, after inquiring for a telecommunication feature, said feature was unavailable for the subscriber, and after completing the inquiry, and after the processing the availability of said feature, was informed that said feature had become available to the subscriber (C. 2, L. 48-54; C. 9, L. 57 - C. 10, L. 7). The motivation to combine Alcott with Panizzon would be to advantageously improve customer service of the telephone service provider by returning the customer call for a desired telecommunication feature.

Response to Arguments

Applicant's arguments filed on 4/6/2005 have been fully considered but they are not persuasive.

In response to the Applicant's argument that the prior art does not teach placing a call to the first party to inform the first party that the first telecommunication feature has become available, it is noted that Panizzon teaches informing the subscriber that a telecommunication feature, which was unavailable for the subscriber, has become available, wherein said "informing" is conducted by causing the subscriber's handset to ring (C. 2, L. 53-54), thereby indicating ability to inform said subscriber by placing a call.

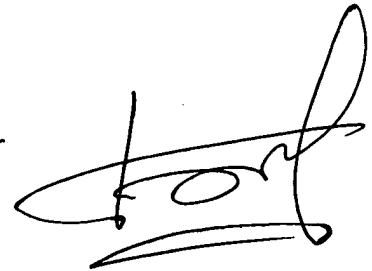
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure (see form PTO-892).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Igor N. Borissov
Patent Examiner
Art Unit 3639

A handwritten signature in black ink, appearing to read 'Igor N. Borissov', with a large, stylized flourish at the end.

IB

1/8/2006